

## **REMARKS/ARGUMENTS**

Claims 124-216 were previously pending in the application. Claims 124, 125, 127-133, 138-142, 144, 146-148, 154, 157-161, 163, 164-166, and 169-216 are amended herein, and new claims 217-235 are added herein. The following table shows the previously-pending claims to which each of new claims 217-234 are equivalent:

New Claim	Equivalent to Previously-Pending Claim
217	131
218	140
219	141
220	144
221	145
222	146
223	148
224	150
225	151
226	152
227	153
228	154
229	155
230	161
231	164
232	166
233	168
234	169

Support for new claim 235 and the amendments to claims 163 and 209 is found in the specification, e.g., at p. 13, lines 5-9. Assuming entry of this amendment, claims 124-235 are now pending. The Applicant hereby requests examination and consideration of the application in view of the foregoing amendments and these remarks.

On page 2 of the Action, the Examiner rejected claims 125, 128, 129, 131, 147, 154, 157, 171, 172, 174, 176, 177, 187, 189, 194, 195, 200, 203, 210, 211, and 213 under 35 U.S.C. §112, second paragraph, as indefinite. In response, the Applicant has amended claims 125, 128, 129, 131, 147, 154, 157, 171, 172, 174, 176, 177, 187, 189, 194, 195, 200, 203, 210, 211, and 213 in a manner believed to overcome these rejections, and it is respectfully submitted that the indefiniteness rejection as to these claims be withdrawn.

On page 3 of the Action, the Examiner rejected claims 124-139, 141, 142, 144, 145, 147-151, 153, 155, 160-164, and 166 under 35 U.S.C. §102(e) as anticipated by U.S. Patent App. Pub. No. 2002/0181009 (“Fredlund”). On page 9 of the Action, the Examiner rejected claims 140, 145, 153, and 154 under 35 U.S.C. §103(a) as obvious over Fredlund. On page 12 of the Action, the Examiner rejected claims 152, 156, 165, and 169 under 35 U.S.C. §103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2005/0022119 (“Kraemer”). On page 14 of the Action, the Examiner rejected claim 146 under 35 U.S.C. §103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2002/0143664 (“Webb”). On page 15 of the Action, the Examiner rejected claims 143 and 167 under 35 U.S.C. §103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2003/0088497 (“Belgrano”). Also on page 15 of the Action, the

Examiner rejected claim 168 under 35 U.S.C. §103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2002/0178078 (“O’Toole”). On page 16 of the Action, the Examiner rejected claims 157-159 under 35 U.S.C. §103(a) as obvious over Fredlund in view of U.S. Patent App. Pub. No. 2004/0219936 (“Kontainen”).

For the following reasons, the Applicant submits that all of the presently-pending claims are allowable over the cited references.

#### Claims 124-216

Claim 124, as amended, recites, *inter alia*, the step of:

(c) receiving, via the communications device, an instruction from the purchaser to purchase at least one selected product or service from the list for a specified recipient different from the purchaser, wherein the at least one selected product or service:

- (i) is capable of being provided to the recipient in person at any venue in the set of one or more venues without the purchaser or the recipient providing any input other than the instruction from the purchaser, and
- (ii) is available for purchase in person at any venue in the set of one or more venues prior to the performance of steps (b) and (c).

In Fredlund, the item being purchased is a customized image-bearing product, such as an 8x10 photograph (paragraph [0029]). Before the image-bearing product can be purchased, two events must first take place: First, either the purchaser or the recipient must upload, in electronic form, an image file (paragraphs [0030] and [0037]). Second, the image-bearing product must be created at a kiosk that contains a printer by printing the contents of the image file onto a print medium, such as paper, stickers, or even T-shirts (paragraph [0032]).

Claim 124 requires that the product or service being purchased be “capable of being provided to the recipient in person at any venue in the set of one or more venues without the purchaser or the recipient providing any input other than the instruction from the purchaser.” In Fredlund, without the image file uploaded by either the purchaser or the recipient, the image-bearing product is not capable of being provided to the recipient. Accordingly, Fredlund fails to teach, disclose, or even suggest this feature of claim 124, because either the purchaser or the recipient must provide as input a portion of what is being purchased, namely, the image file to be printed on a print medium.

Claim 124 further requires that the product or service being purchased be “available for purchase in person at any venue in the set of one or more venues prior to the performance of steps (b) and (c).” In Fredlund, the image-bearing product is not available for purchase at the time step (b) is performed. Nor is the image-bearing product available for purchase at the time step (c) is performed. This is because, at the time steps (b) and (c) are performed, an image file has not yet been supplied by either the purchaser or the recipient, and therefore, the product being purchased does not yet exist. At best, Fredlund presents the purchaser a selection of generic features or processing options for distributing a photograph (e.g., at the time the recipient visits the kiosk, print the photograph on 8x10 paper, print the photograph on a t-shirt, etc.), but this is not the same as a list of products that are available for purchase, because these items do not actually exist until someone supplies an image file. Accordingly, Fredlund fails to teach, disclose, or even suggest this feature of claim 124, because the custom image-bearing product is not available for purchase until after steps (b) and (c) are performed and an image file is uploaded by either the purchaser or the recipient.

Since Fredlund fails to teach, disclose, or even suggest the foregoing features recited in claim 124, it cannot be said that Fredlund anticipates claim 124. For similar reasons, claims 170 and 216 are also novel over Fredlund. Since claims 125-169 and 171-215 depend variously from claims 124 and 170, it is further submitted that those claims are also novel over Fredlund.

#### New Claim 217 and Claim 131

New claim 217, which is substantially equivalent to previously-pending claim 131 rewritten in independent form, recites, *inter alia*, that:

step (c) comprises transmitting the data enabling the authentication of the recipient to all of the venues of the set of one or more venues in advance of presentation by the recipient of (i) an identifier, (ii) a physical medium having an identifier printed thereon, or (iii) a physical device enabling authentication of the recipient to receive the at least one specified product or service.

In rejecting previously-pending claim 131 as anticipated by Fredlund on page 5 of the Action, the Examiner cites to paragraph [0047] of Fredlund, which reads as follows:

[0047] Other means that allows the kiosk to recognize identifier ID could include, for example, a radio frequency (RF) transponder. Accordingly, the postcard would comprise an RF tag having identifier ID. Alternatively, if the postcard includes a magnetic stripe having identifier ID, the kiosk could include a magnetic head for reading the magnetic stripe. Still further, if identifier ID is a bar code, the postcard could be read by the kiosk if the kiosk included a bar code reader. Identifier ID is illustrated as a bar code on postcards 40, 60, 70, 80 as illustrated in FIGS. 5(b), 9(b), 10(b), and 11(b), respectively. In addition, a kiosk employing a print scanner and optical character reader software, hereinafter referred to as OCR software, could use eye readable alphanumeric text to recognize identifier ID.

As can be seen from the text of paragraph [0047], nowhere does this paragraph teach, disclose, or even suggest a step of transmitting authentication data to ALL of the venues in the set of one or more venues PRIOR TO the recipient presenting an identifier or device to authenticate the recipient's receipt of a product or service. In other words, according to claim 217, once the instruction from the purchaser is received, the authentication data is sent to all of the potential venues at which the recipient could receive the product or service – not just the single location at which the recipient chooses to receive the product or service, as taught in Fredlund. Additionally, the authentication data is sent before redemption by the recipient, in contrast to Fredlund, which authenticates the recipient's receipt of a product or service at the time of redemption. Neither paragraph [0047] of Fredlund, nor any other portion of Fredlund, discloses transmitting the data enabling the authentication of the recipient to all of the venues of the set of one or more venues in advance of presentation by the recipient of (i) an identifier, (ii) a physical medium having an identifier printed thereon, or (iii) a physical device enabling authentication of the recipient to receive the at least one specified product or service. Therefore, new claim 217 is novel over Fredlund. For similar reasons, presently-pending claim 131 is also novel over Fredlund.

#### New Claims 218-219 and Claims 140-141

New claim 218, which is substantially equivalent to previously-pending claim 140 rewritten in independent form, recites, *inter alia*, the steps of:

(c) receiving an instruction from the recipient to purchase at least one specified product or service for the purchaser, the at least one specified product or service to be provided to the purchaser in person at any venue in a second set of one or more venues; and

(d) transmitting to the recipient a notification corresponding to the instruction, wherein at least a portion of the instruction from the recipient is pre-supplied without input from the recipient.

In rejecting previously-pending claim 140 as obvious over Fredlund on page 9 of the Action, the Examiner acknowledges that Fredlund teaches none of the foregoing features but cites to paragraphs [0029], [0030], and [0034] of Fredlund, asserting that the “[m]ethod step recited in Fredlund would remain the same regardless who is the purchaser and who is the recipient, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said purchaser is a recipient, because it would advantageously allow to increase revenue.” This argument ignores limitations recited in claim 217.

Claim 218 recites, *inter alia*, that, in addition to the purchaser buying a product or service for the recipient, the recipient also buys a product or service for the recipient, and “at least a portion of the instruction from the recipient is pre-supplied without input from the recipient.” This means that the recipient does not need to input a portion of the instruction from the recipient, such as the product or service being purchased or the venue(s) at which redemption occurs. This is because the original purchaser has indicated, e.g., his/her favorite drink and/or venue preference as part of his/her “instant reciprocity” settings (see the Applicant’s specification at p. 25, lines 21-22), and these stored settings are used to pre-populate the fields of the instruction from the recipient. An exemplary embodiment of this process is fully described in the Applicant’s specification, e.g., at p. 25, line 15, to p. 28, line 14. Neither the cited paragraphs [0029], [0030], and [0034] of Fredlund nor any other portion of Fredlund teaches, discloses, or even suggests a transaction in which the purchaser and recipient switch roles, and the recipient can initiate the “reciprocal” purchase instruction without having to input a portion of the instruction because that portion of the instruction is pre-supplied. Therefore, new claim 218 is non-obvious over Fredlund. For similar reasons, presently-pending claim 140 is also non-obvious over Fredlund.

In addition to new claim 219 being allowable because it depends from allowable new claim 218, as argued above, claim 219 also includes subject matter not taught, disclosed, or even suggested in Fredlund. Claim 219 recites, *inter alia*, that the pre-supplied portion of the instruction “comprises at least one of (i) a purchaser name, (ii) a purchaser email address, (iii) a purchaser text messaging address, (iv) one or more venues, (v) one or more products or services, and (vi) payment information.” In rejecting previously-pending claim 141 (which is equivalent to new claim 219) as anticipated by Fredlund on page 6 of the Action, the Examiner cites to item 44 of Fig. 9(a) of Fredlund. Item 44 is a purchaser’s name and address, as printed on a postcard generated by Fredlund’s system to notify a recipient of his/her opportunity to claim an image-bearing product purchased by the purchaser. This is completely unrelated to the original purchaser having indicated, e.g., his/her favorite drink and/or venue preference as part of his/her “instant reciprocity” settings (see the Applicant’s specification at p. 25, lines 21-22), and using these stored settings to pre-populate the fields of the instruction from the recipient, as discussed above with reference to claim 218. Neither item 44 of Fig. 9(a) of Fredlund nor any other portion of Fredlund teaches, discloses, or even suggests a pre-supplied portion of a purchase instruction at all, let alone pre-supplying any of items (i)-(vi) of claim 219 as a portion of a purchase

instruction. This provides additional reasons for the assertion that claim 219 is allowable over Fredlund. For similar reasons, presently-pending claim 141 is also allowable over Fredlund.

#### New Claim 220 and Claim 144

New claim 220, which is substantially equivalent to previously-pending claim 144 rewritten in independent form, recites, *inter alia*, that “the instruction specifies a plurality of specified products or services, each at a different set of one or more venues associated with the same recipient.” In rejecting previously-pending claim 144 as anticipated by Fredlund on page 7 of the Action, the Examiner cites to paragraph [0032] of Fredlund, which reads as follows:

[0032] In step 122, recipient R can view image I on input means 30 of kiosk 18. Recipient R may also view any option(s) for image I which have been selected by user U (though user U may not have selected any options). If user U selected option(s), user U may have already provided payment for the selected option(s). The payment may have been provided by user U by means of entering his credit card number. User U may also enter a monetary limit for the transaction. For the particular example given above, user U may have paid for the 8x10 photograph. Other options which may have been selected by user U or recipient R include a single or multiple copies, stickers, cards, posters, and value-added services such as enlargements, borders, and special image effects. Further options may include other photo products such as a tee shirt, mug, calendar, puzzle, photo CD, mouse pad, book bag, album page, and cake decoration. When the output option(s) for the image bearing product has been selected by recipient R (step 122), recipient R can direct kiosk 18 to print the selected image bearing product(s) (step 124).

As can be seen from the text of paragraph [0032], nowhere does this paragraph teach, disclose, or even suggest a single purchase instruction that specifies a plurality of products or services to purchase, wherein each of the products or services is at a DIFFERENT set of one or more venues associated with the SAME recipient. An example of this is described in the Applicant’s specification at p. 28, line 18, to p. 29, line 2, in which a purchaser buys different drinks for the recipient at different venues for a “barhopping” itinerary. Neither paragraph [0032] of Fredlund, nor any other portion of Fredlund, discloses a single instruction that specifies a plurality of specified products or services, each at a different set of one or more venues associated with the same recipient. Therefore, new claim 220 is novel over Fredlund. For similar reasons, presently-pending claim 144 is also novel over Fredlund.

#### New Claim 221 and Claim 145

New claim 221, which is substantially equivalent to previously-pending claim 145 rewritten in independent form, recites, *inter alia*, that “the instruction specifies a specific product or service for each of a plurality of different recipients associated with the set of one or more venues.” In rejecting previously-pending claim 145 as obvious over Fredlund on page 10 of the Action, the Examiner states: “However, it would not be feasible to create such a system just for one recipient, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include plurality of different recipients, because it would advantageously allow to generate revenue.” This argument ignores limitations recited in claim 221, which recites that a single instruction specifies a product or service to purchase for each of a plurality of different recipients associated with the same set of one or more venues. Of course, the system of Fredlund can be used with a plurality of recipients, as the Examiner suggests, but nowhere does Fredlund teach, disclose, or even suggest a single purchase instruction that specifies a plurality of different recipients. An example of this is described in the

Applicant's specification at p. 29, lines 3-9, in which a purchaser buys drinks for a group of recipients in a single "group purchase transaction." Fredlund fails to teach, disclose, or suggest a single instruction that specifies a specific product or service for each of a plurality of different recipients associated with the set of one or more venues. Therefore, new claim 221 is novel over Fredlund. For similar reasons, presently-pending claim 145 is also novel over Fredlund.

#### New Claim 222 and Claim 146

New claim 222, which is equivalent to previously-pending claim 146 rewritten in independent form, recites, *inter alia*, the steps of:

- (c) receiving, from a remote communications device used by the purchaser, a message indicating selection of a link (i) on a web or browser page or (ii) in an electronic or text message; and
- (d) initiating step (a) based on receipt of the message.

In rejecting previously-pending claim 146 as obvious over Fredlund in view of Webb on page 14 of the Action, the Examiner acknowledges that Fredlund fails to teach the foregoing limitations of claim 146 and cites to paragraph [0039] of Webb, which reads as follows:

[0039] A gift reminder and purchasing method and system of the present invention carries many advantageous features. Foremost, the method and system simultaneously remind a user to get a gift for a specific person by a specific date and provides the means to purchase the gift immediately from the location of the reminder. In particular, the method and system provides the user with at least one link to a gift merchant web site that sells a gift related to a previously determined gift idea of the user. By activating the link, the user can immediately purchase the gift without having to embark on their own search or without having to remember to go to retail store to buy the gift. Remembering that a gift is needed is only part of gift giving. This system and method will help users succeed in the exact place that most fail in gift giving: actually buying the gift.

The Examiner alleges that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include selection of a link, as disclosed in Webb, because it would advantageously allow the user immediately purchase the gift without having to embark on their own search or without having to remember to go to retail store to buy the gift, as specifically taught by Webb." This argument ignores limitations recited in claim 222, which recites that step (a), i.e., receipt of the instruction to purchase itself, is initiated based on the receipt of a message indicating that the purchaser has selected a link (e.g., a hypertext link) on a web page or in a text message. This is quite different from what is disclosed in paragraph [0039] of Webb, which teaches sending a message to a potential purchaser containing a URL link to a "gift reminder web site home page" or "gift reminder web site search results" (paragraph [0034] of Webb) or a URL link to a "gift merchant that sells the suggested gifts" (paragraphs [0035], [0036], and [0037] of Webb). In Webb, clicking on the link takes the purchaser only to search results pages, home pages, or merchant pages that require the purchaser to at least navigate to the item and/or initiate a purchase instruction to purchase the item. In contrast, in the present invention as claimed in claim 222, clicking on the link actually initiates an instance of a purchase instruction, as described in the Applicant's specification, e.g., at p. 27, lines 14-16. Neither paragraph [0039] of Webb nor any other portion of Webb teaches, discloses, or even suggests initiating the receipt of a purchase instruction as claimed in step (a) based on receipt of a message indicating that the purchaser has selected a link (e.g., a hypertext link) on a web page or in a text message. Nor does Fredlund supply the missing teachings. Therefore, no combination of

Fredlund and Webb could possibly render claim 222 obvious. For similar reasons, presently-pending claim 146 is also non-obvious over Fredlund and Webb.

#### New Claims 223-225 and Claims 148, 150, and 151

New claim 223, which is equivalent to previously-pending claim 148 rewritten in independent form, recites, *inter alia*, the steps of:

- (c) transmitting data to enable displaying to the purchaser, on a communications device, a list of one or more possible venues;
- (d) receiving from the purchaser a selection of the set of one or more venues from the list of one or more possible venues;
- (e) receiving location-based information obtained from a device or token associated with the recipient; and
- (f) generating the list of one or more possible venues based on the location-based information.

In rejecting previously-pending claim 148 as anticipated by Fredlund on page 7 of the Action, the Examiner cites to paragraph [0045] of Fredlund, which reads as follows:

[0045] The notification may also alert the user/recipient/consumer to kiosks which are close to their addresses. The location of these kiosks can be selected from a list of networked kiosks that are geographically close. For example, the locations of these kiosks could be provided in store location area 52, as shown in FIG. 10(b).

As can be seen from the text of paragraph [0045], nowhere does this paragraph teach, disclose, or even suggest step (e), i.e., receiving location-based information obtained from a device or token associated with the recipient. An example of this is described in the Applicant's specification at p. 55, lines 1-12, in which an RFID reader is positioned near the doors of venues, which track the entrance and exit of end users carrying RFID tags and relays this information to a server to establish a complete "map" of which individuals are in which venues in real or near-real time. Further, in addition to the use of RFID tags and readers, page 58, lines 1-5 of the Applicant's specification explains that location-based methodologies that may be used in a system consistent with the invention also include global-positioning system (GPS) or other wireless location services, e.g., Bluetooth, 802.11 or mobile telephony tower-based triangulation. According to claim 223, the location-based information is used in step (f) to generate a list of one or more possible venues that are displayed to the purchaser in step (c) and from which a selection is made by the purchaser in step (d). Using such location-based information permits a list of venues to be generated that corresponds to the location of the recipient, e.g., the purchaser can see that the recipient is near a particular venue at the time of purchase, so that the purchaser can buy a drink for the recipient at a venue close to where the recipient is actually located. To the contrary, paragraph [0045] of Fredlund describes including, in a notification to the recipient such as a postcard, locations of kiosks where an image-bearing product can be printed and redeemed. Neither paragraph [0045] of Fredlund, nor any other portion of Fredlund, discloses receiving location-based information obtained from a device or token associated with the recipient, generating a list of one or more possible venues based on the location-based information, displaying the list to a purchaser, and receiving from the purchaser a selection of one or more venues from the list. Therefore, new claim 223 is novel over Fredlund. For similar reasons, presently-pending claim 148 is also novel over Fredlund.

In addition to new claims 224 and 225 being allowable because they depend from allowable new claim 223, as argued above, claims 224 and 225 also include subject matter not taught, disclosed, or even suggested in Fredlund. Claim 224 recites that the device or token is a location-enabled mobile telephone, and claim 225 recites that the device or token is a device operating according to an 802.11 standard. In rejecting previously-pending claims 150 and 151 as anticipated by Fredlund on page 7 of the Action, the Examiner cites to paragraph [0043] of Fredlund, which reads as follows:

[0043] Postcard 40, first postcard 60 and/or second post 70 are used for notification, and this notification may not be limited to this form. For example, email messages may be used to provide notification to the user/recipient and first and second consumer. Also, automated telephone messages may be used for notification. Wireless communication means might also be employed.

Nowhere does this paragraph teach, disclose, or even suggest the use of location-based information from a location-enabled mobile phone (e.g., a GPS-capable phone or a mobile phone whose location is detectable based on the cell towers with which it is in communication) or an 802.11-compatible device (e.g., a WiFi device such as a laptop computer or a WiFi phone) to generate a list of venues corresponding to the location of the recipient, from which the purchaser can make a selection at the time of purchase. Neither paragraph [0043] of Fredlund nor any other portion of Fredlund teaches, discloses, or even suggests the use of location-based information from a location-enabled mobile phone or an 802.11-compatible device. This provides additional reasons for the assertion that claims 224 and 225 are allowable over Fredlund. For similar reasons, presently-pending claims 150 and 151 are also allowable over Fredlund.

#### New Claim 226 and Claim 152

New claim 226, which is equivalent to previously-pending claim 152 rewritten in independent form, recites, *inter alia*, the step of “(e) using a historical list of one or more venues visited by the recipient to generate the list of possible venues.” In rejecting previously-pending claim 152 as obvious over Fredlund and Kraemer on page 12 of the Action, the Examiner cites to paragraphs [0011] and [0035] of Kraemer, which read as follows:

[0011] What is needed is a single gift registry service that is compatible with more than one retailer. What is needed is a gift registry solution which allows a gift-recipient to visit a single location and create a gift registry which includes products from more than one retailer. What is also needed is a gift registry solution which allows a gift-giver to visit a single location and access a gift registry which includes products from more than one retailer.

[0035] A gift-recipient accesses enhanced functionality server 100 and then browses vendor and product webpages normally. Enhanced functionality server 100 may present a list of retailers. The list of retailers may be a suggested or preferred list of retailers, or prepared in response to the gift-recipient's previous selections. However, the gift-recipient is also able to shop at unlisted retailers, the supplied list provided only for the gift-recipient's convenience. The gift-recipient selects a link to the retailer website of their choice by clicking on the appropriate listing as displayed on their browser. Enhanced functionality server 100 "follows" the gift-recipient and stores information about the webpages the gift-recipient has visited. The gift-recipient may request any particular product webpage.

The Examiner argues that paragraph [0035] of Kraemer “teaches a method of providing enhanced functionality to product web pages wherein the list of retailers may be suggested in response to the gift-recipient’s previous selections,” concluding that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include the list of one or more possible venues is generated based on a profile or criteria associated with the recipient, as disclosed in Kraemer, because it would advantageously allow a gift giver to visit a single location and access a gift registry which includes products from more than one retailer, as specifically taught by Kraemer” in paragraph [0011]. This is different from what is claimed in claim 226. Claim 226 recites using a historical list of one or more venues visited by the recipient to generate the list of possible venues. Kraemer teaches generating a list of retailers “in response to the gift-recipient’s previous selections.” While paragraph [0035] of Kraemer does state that “[e]nhanced functionality server 100 ‘follows’ the gift-recipient and stores information about the webpages the gift-recipient has visited,” it is clear from paragraph [0035] of Kraemer that it is NOT the list of “webpages the gift-recipient has visited” that is used as the list of possible webpages from which a purchaser can select to purchase a gift. Rather, the recipient himself/herself uses the stored information about the webpages he/she has visited, as a sort of “reminder,” from which to manually select a list of retailers and gifts that will eventually be presented to the purchaser for selection. Neither paragraph [0035] of Kraemer nor any other portion of Kraemer teaches, discloses, or even suggests using a historical list of one or more venues visited by the recipient to generate the list of possible venues. Nor does Fredlund supply the missing teachings. Therefore, no combination of Fredlund and Kraemer could possibly render claim 226 obvious. For similar reasons, presently-pending claim 152 is also non-obvious over Fredlund and Kraemer.

#### New Claims 227-229 and Claims 153-155

New claim 227, which is equivalent to previously-pending claim 153 rewritten in independent form, recites, *inter alia*, the steps of:

- (c) transmitting data to enable displaying to the purchaser, on a communications device, a list of one or more possible venues;
- (d) receiving from the purchaser a selection of the set of one or more venues from the list of one or more possible venues, wherein the recipient specifies the list of one or more possible venues; and
- (e) receiving the list of one or more possible venues from the recipient.

The Examiner cites to paragraph [0034] of Fredlund in rejecting previously-pending claim 153 as obvious over Fredlund on page 10 of the Action, asserting that the “[m]ethod step recited in Fredlund would remain the same regardless who is the purchaser and who is the recipient, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said purchaser is a recipient, because it would advantageously allow to increase revenue.” First, this argument also makes no sense, because the purchaser is not a recipient in claim 227! Second, paragraph [0034] of Fredlund simply does not teach, disclose, or even suggest what is being claimed. Claim 227 recites that the recipient supplies the list of venues from which the purchaser makes a selection. Paragraph [0034] of Fredlund reads as follows:

[0034] The back view of postcard 40 shows a message area 48 for the inclusion of a message for recipient R. Message area 48 can, for example, provide notification of user's U creation of an image bearing product. This may be an automatic message or a message generated by user U. Postcard 40 also includes an identifier area 50 for the inclusion of

identifier ID. Postcard 40 preferably includes a store location area 52, providing, for example, a listing of the names/addresses of stores having kiosks. If recipient R's image bearing product is a photo product such as a tee shirt or mug, store location area 52 could specify the specific store/location for recipient R to pick up the product. Optionally, store location area 52 may be used as an advertising area, for example for advertising specific stores, store events, store openings, store coupons, and special store promotions.

It can plainly be seen that paragraph [0034] does not disclose that a recipient supplies a list of venues from which the purchaser makes a selection. Therefore, the Examiner has not set forth a *prima facie* case for obviousness of claim 227, and claim 227 is non-obvious over Fredlund. For similar reasons, presently-pending claim 153 is also non-obvious over Fredlund.

In addition to new claims 228 and 229 being allowable because they depend from allowable new claim 227, as argued above, claims 228 and 229 (which are substantially equivalent to previously-pending claims 154 and 155 rewritten in independent form) also include subject matter not taught, disclosed, or even suggested in Fredlund.

New claim 228 recites that the specification of the list of one or more possible venues by the recipient occurs at a substantially different time from the receipt of the instruction in step (a). In rejecting previously-pending claim 154 as obvious over Fredlund on page 9 of the Action, the Examiner argues that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said “specification” [of the list of venues] and “receiving” [of the instruction in step (a)] steps are conducted substantially simultaneously or at the same time, because it would advantageously allow the purchaser/recipient to take time to make a decision in selecting the most appropriate venue. This argument does not make sense. This is because claim 228 recites that the “specification” and “receiving” steps occur at substantially different times, not substantially simultaneously or at the same time, as argued by the Examiner. Thus, the Examiner has not set forth a *prima facie* case for obviousness of claim 228, and claim 228 is non-obvious over Fredlund. For similar reasons, presently-pending claim 154 is also non-obvious over Fredlund.

New claim 229 recites that “the recipient specifies a single venue as the list of one or more possible venues, the single venue being a venue at which the recipient is currently located.” In rejecting previously-pending claim 155 as obvious over Fredlund on page 11 of the Action, the Examiner cites to paragraphs [0029], [0030], and [0034] of Fredlund, asserting that the “[m]ethod step recited in Fredlund would remain the same regardless who is the purchaser and who is the recipient, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that said purchaser is a recipient, because it would advantageously allow to increase revenue.” This argument also makes no sense, because the purchaser is not a recipient in claim 229! To the contrary, claim 229 recites that the recipient specifies the venue at which he/she is currently located as a venue to present to the purchaser when making the purchase. Neither paragraphs [0029], [0030], and [0034] of Fredlund, nor any other portion of Fredlund discloses, teaches, or even suggests a recipient specifying a single venue as the list of one or more possible venues, wherein the single venue is a venue at which the recipient is currently located. Again, the Examiner has not set forth a *prima facie* case for obviousness of claim 229, and claim 229 is non-obvious over Fredlund. For similar reasons, presently-pending claim 155 is also non-obvious over Fredlund.

#### New Claim 230 and Claim 161

New claim 230, which is equivalent to previously-pending claim 161 rewritten in independent form, recites, *inter alia*, that “the purchaser transmits the instruction using a physical device located remotely from the venues in the set of one or more venues.” In rejecting previously-pending claim 161 as anticipated by Fredlund on page 8 of the Action, the Examiner cites to paragraph [0031] of Fredlund, which reads as follows:

[0031] Still referring to FIG. 3, the postcard is sent to recipient R (step 112). In step 114 recipient R takes identifier ID to any of the network connected kiosks, which for illustrative purposes is represented in FIG. 3 as kiosk 18. Recipient R inputs identifier ID to kiosk 18 (step 116) by means of input means 30, or by scanning the postcard on scanner 32, or by any other means that allows kiosk 18 to recognize identifier ID, for example, a bar code reader. Upon receiving identifier ID, kiosk 18 queries the network (step 1118), represented by server 22, for the location of image I that has been input by user U. Image I may reside on kiosk 10, kiosk 12, kiosk 14, kiosk 16, or at some other point on the network such as server 22. Image I may be stored at any network accessible location, for example, at a network accessible location identified by identifier ID. Though identifier ID need not identify the network accessible location of image I. Once the location of image I is determined, image I is transmitted to kiosk 18 (step 120).

It can plainly be seen that paragraph [0031] does not disclose that the purchaser transmits the instruction using a physical device located remotely from the venues in the set of one or more venues. In fact, quite to the contrary, the only locations disclosed in paragraph [0031] are kiosks that are located at the venues! Therefore, the Examiner has not set forth a *prima facie* case for anticipation of claim 230, and claim 230 is novel over Fredlund. For similar reasons, presently-pending claim 161 is also novel over Fredlund.

#### New Claim 231 and Claim 164

New claim 231, which is equivalent to previously-pending claim 164 rewritten in independent form, recites, *inter alia*, the step of “(c) prior to steps (d) and (e), receiving a list of one or more available products or services from the recipient.” In rejecting previously-pending claim 164 as anticipated by Fredlund on page 8 of the Action, the Examiner cites to paragraph [0032] of Fredlund, which reads as follows:

[0032] In step 122, recipient R can view image I on input means 30 of kiosk 18. Recipient R may also view any option(s) for image I which have been selected by user U (though user U may not have selected any options). If user U selected option(s), user U may have already provided payment for the selected option(s). The payment may have been provided by user U by means of entering his credit card number. User U may also enter a monetary limit for the transaction. For the particular example given above, user U may have paid for the 8x10 photograph. Other options which may have been selected by user U or recipient R include a single or multiple copies, stickers, cards, posters, and value-added services such as enlargements, borders, and special image effects. Further options may include other photo products such as a tee shirt, mug, calendar, puzzle, photo CD, mouse pad, book bag, album page, and cake decoration. When the output option(s) for the image bearing product has been selected by recipient R (step 122), recipient R can direct kiosk 18 to print the selected image bearing product(s) (step 124).

It can plainly be seen that paragraph [0032] does not disclose a step of receiving a list of one or more available products or services from the recipient prior to steps (d) (displaying to the purchaser, on a communications device, the list of one or more available products or services)

and (e) (receiving from the purchaser a selection of the at least one product or service from the list of one or more available products or services). Rather, paragraph [0032] instead describes a recipient selecting products other than what the purchaser had originally indicated after the purchaser has already made the purchase! (See paragraph [0029] of Fredlund, which states that in the example of paragraph [0032], “a person, located in California, wishes to send his cousin, located in New York, an 8x10 photograph of their grandmother on her 80th birthday”.) Therefore, the Examiner has not set forth a *prima facie* case for anticipation of claim 231, and claim 231 is novel over Fredlund. For similar reasons, presently-pending claim 164 is also novel over Fredlund.

#### New Claim 232 and Claim 166

New claim 232, which is equivalent to previously-pending claim 166 rewritten in independent form, recites, *inter alia*, the step of “(c) storing an account balance for the purchaser.” In rejecting previously-pending claim 166 as anticipated by Fredlund on page 8 of the Action, the Examiner cites to paragraph [0049] of Fredlund, which reads as follows:

[0049] System 5 may include means for paying for the image bearing product. For example, payment may be provided by the user by entering a credit card number to a kiosk using either a keypad or other known credit card reading device. Thus, system 5 would charge the user's credit card account. The user could limit the dollar amount that may be charged. In this manner, the recipient may choose from a number of output options that have differing prices. Optionally, payment may be provided to a store clerk (or other point of sale capability) by cash, check, or credit card, and the store clerk could acknowledge the prepayment for the image bearing product via the kiosk.

It can plainly be seen that paragraph [0049] does not disclose a step of storing an account balance for the purchaser. Rather, paragraph [0049] describes using traditional payment methods, such as cash, check, or credit card, to make payment. Nor does any other portion of Fredlund disclose a step of storing a purchaser's account balance. Therefore, claim 232 is novel over Fredlund. For similar reasons, presently-pending claim 166 is also novel over Fredlund.

#### New Claim 233 and Claim 168

New claim 233, which is equivalent to previously-pending claim 168 rewritten in independent form, recites, *inter alia*, that “the instruction comprises a specified date and/or time for a notification corresponding to the instruction to be provided to the recipient,” as well as the step of “(b) delaying the notification until the specified date and/or time.” In rejecting previously-pending claim 168 as obvious over Fredlund in view of O'Toole on page 15 of the Action, the Examiner acknowledges that Fredlund fails to teach “that the instruction comprises a specified date and/or time for the notification to be provided to the recipient” and “delaying the notification until the specified date and/or time” and cites to paragraph [0030] of O'Toole, which reads as follows:

[0030] Next the user can select a level of service for each client that determines when a card, note, letter or gift will be sent in the future on a specific date. The “level of service” feature of the site is one advantage of the invention and solves the existing problem of many current methods of delivering items in the future. This unique feature eliminates the need for reminders and a return to the site. Users simply select a client, trigger the service level by filling in a button in a table, and the service triggered is fulfilled in time to reach the destination on the date the user has entered for that specific client. There is no need

for the user to return to the site or for the vendor to keep a paper list or electronic reminder list. The process we invented stores the data and creates an order at the appropriate time. The higher the level of service the more expensive and more often an item of correspondence is sent. The user can use a recommended set of items or fully customize what and when they would like something sent. These "level of service" tables are inclusive of both printed correspondence and gift type items [sic].

The Examiner asserts that "O'Toole teaches a method for retaining clients by automated services fulfillment wherein the user can select a level of service for each client that determines when a card, note, letter or gift will be sent in the future on a specific date," concluding that:

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include that the instruction comprises a specified date and/or time for the notification to be provided to the recipient; and further comprising delaying the notification until the specified date and/or time, as disclosed in O'Toole, because it would advantageously allow to eliminate the need for reminders and a return to the site, or for the vendor to keep a paper list or electronic reminder list, as specifically taught by O'Toole.

First, the motivation provided by the Examiner to combine Fredlund and O'Toole makes no sense. Eliminating the need "for the vendor to keep a paper list or electronic reminder list" has nothing to do with the present invention, as claimed in claim 233. There is no "vendor" who would keep "a paper list or electronic reminder list" in the absence of a feature as claimed in claim 233. If anything, the feature of delaying notification, e.g., until a recipient's birthday, benefits the purchaser and the recipient – but there is no benefit to a "vendor" in the context of the present invention. Second, O'Toole is clearly non-analogous art, dealing with the management of client correspondence and other client communications in a business setting. One skilled in the art of Fredlund, i.e., providing image-bearing products, would not have turned to O'Toole for guidance regarding delayed gifting. Accordingly, Fredlund and O'Toole cannot properly be combined to render claim 233 obvious. The Applicant submits therefore that claim 233 is non-obvious over Fredlund and O'Toole. For similar reasons, presently-pending claim 168 is also non-obvious over Fredlund and O'Toole.

#### New Claim 234 and Claim 169

New claim 234, which is equivalent to previously-pending claim 169 rewritten in independent form, recites, *inter alia*, the step of "(a) prior to steps (b) and (c), receiving from a recipient and transmitting to a plurality of purchasers a message indicating at least one desired good or service and/or at least one venue specified by the recipient." An example of this is described in the Applicant's specification at p. 29, lines 10-16, wherein an end user sends out a broadcast message (e.g., to a group of friends) inviting recipients to buy him or her a particular drink at a particular venue. In rejecting previously-pending claim 169 as obvious over Fredlund in view of Kraemer on page 13 of the Action, the Examiner acknowledges that Fredlund fails to teach "prior to receipt of the instruction from the purchaser, receiving from a recipient and transmitting to a plurality of purchasers a message indicating at least one desired good or service and/or at least one venue specified by the recipient," citing to paragraph [0046] of Kraemer, which reads as follows:

[0046] 11. Obtaining information about a purchaser. A gift-giver accesses the gift-recipient's gift registry by accessing enhanced functionality server 100. Enhanced functionality server 100 may use a series of question and answer forms to obtain

information about the gift-giver, such as name and credit card information, and to make sure the gift-giver accesses the proper gift-recipient's gift registry. Having positively identified and supplied the correct authentication, the gift-giver may be presented with a series of screens, the total of which displays the gift-recipient's list of registered gifts. The gift-recipient's account is displayed, along with a registry list which is a list of links, one for each gift registered by the gift-recipient. Products are listed by title offering the gift-giver a way to review each registered gift. Each listing also displays the gift's purchase status (reserved or available), and offers the gift-giver the option to view more details on the gift and to purchase the gift. The gift-giver may freely browse the product webpages, which are modified to include toolbar 150 in the same way as when the gift-recipient had browsed the product webpages. To do this, information about the selected gift, and its URL and frameset structure is retrieved from where it was stored earlier.

The Examiner alleges that "Kraemer teaches a method for providing enhanced functionality to product web pages wherein the gift recipient's list of registered gifts are displayed to the gift giver," concluding that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fredlund to include receiving from a recipient a list of desired goods or services, as disclosed in Kraemer, because it would advantageously allow to avoid duplicate gift purchases." First, Kraemer fails to teach, disclose, or even suggest what is claimed in claim 234, namely, receiving from a recipient and transmitting to a plurality of purchasers a message indicating at least one desired good or service and/or at least one venue specified by the recipient. In Kraemer, a single purchaser can browse a registry that stores items indicated as desired by a recipient. However, Kraemer does not use a message that is sent to a plurality of purchasers as a way of notifying the purchasers about the desired items. Neither paragraph [0046] of Kraemer nor any other portion of Kraemer teaches, discloses, or even suggests using a message sent to a plurality of purchasers as recited in claim 234. Nor does Fredlund supply the missing teachings. Moreover, the motivation to combine Fredlund and Kraemer provided by the Examiner, i.e., "it would advantageously allow to avoid duplicate gift purchases," makes no sense. In the present invention, as claimed in claim 234, there is no attempt made to avoid duplicate gift purchases. Indeed, informing a plurality of purchasers of a desired gift, i.e., a drink at a venue, using a message sent to all of the purchasers, could desirably bring a recipient multiple instances of the same gift, i.e., several drinks at the venue. This is quite different from a gift registry, in which an item is removed from the registry once purchased. Therefore, Fredlund and Kramer cannot properly be combined to render 234 obvious, and even if these references were properly combinable, no combination of Fredlund and Kraemer could possibly render claim 234 obvious. For similar reasons, presently-pending claim 169 is also non-obvious over Fredlund and Kraemer.

#### New Claim 235 and Claims 163 and 209

New claim 235 recites, *inter alia*, that "the at least one product or service is a beverage." Neither Fredlund nor any other of the cited references discloses a computer-implemented system or method for enabling the purchase of a beverage. Therefore, new claim 235 is allowable over all of the cited references. For similar reasons, presently-pending claims 163 and 209 are also allowable the cited references.

#### Claims 170-216

The Applicant respectfully notes that none of previously-pending claims 170-216 were rejected based on any prior art references in the Action, although some of these claims were rejected under 35 U.S.C. §112, as discussed above. Based on the Examiner's stated art rejections

of previously-pending claims 124-169, the Applicant could infer that claims 170-216 were intended to be rejected based on prior art references. However, the Applicant has not been provided with an opportunity to address these claim rejections substantively and therefore respectfully requests that the Examiner provide a basis for rejecting these claims in a subsequent action, should the Examiner find that the application is not in condition for allowance following the entry of this Amendment. Additionally, should the Examiner reject any of claims 170-216 based on any prior art references in a subsequent office action, the Applicant respectfully notes that such office action must be a non-final action, pursuant to MPEP §706.07, since none of claims 170-216 were rejected in the 9/27/06 Action based on any prior art references.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

In the event that the Examiner believes that this Preliminary Amendment does not place the application in condition for allowance, the Applicant requests a telephonic interview between the Examiner and the Applicant's attorney Kevin Drucker to discuss this Amendment. The Applicant requests that the Examiner call Mr. Drucker (215-557-6659) to arrange a convenient time for such an interview.

Respectfully submitted,

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